

**REMARKS**Claim Changes

Claims 1, 21, 32, and 33 have been amended to recite “independent of call activity involving the MS.” These changes are based at least on page 9 lines 9 – 10 and page 11 lines 2 - 3 of the specification as filed. Thus, no new matter has been added.

Unrelated to patentability, the applicants have canceled, without prejudice or disclaimer, claims 3, 6-10, 12-15, 17, 30 and 31 to save expenses related to the number of claims. Claims 5, 11 and 29 have been amend to include language from some of the canceled claims.

No amendment made is related to the statutory requirements of patentability unless expressly stated herein. No amendment is made for the purpose of narrowing the scope of any claim, unless Applicant had argued herein that such amendment is made to distinguish over a particular reference or combination of references. Any remarks made herein with respect to a given claim or amendment is intended only in the context of that specific claim or amendment, and should not be applied to other claims, amendments, or aspects of Applicant's invention.

Rejection of claims 1, 2, 5 – 8, 10, 11, 13, and 16 - 20 under 35 U.S.C. § 103(a) as being unpatentable over US 2004/0170263 (Michael et al.) in view of US 2003/0065788 (Salomaki), and in further view of US 2004/0234061 (Koch et al.)

Applicant has amended the claims to clarify the invention and has canceled claims 6-8, 13 and 17. Applicant therefore respectfully requests reconsideration of the rejection of claims 1, 2, 5 – 8, 10, 11, 13, and 16 - 20 under 35 U.S.C. § 103(a) as being unpatentable over Michael in view of Salomaki and in further view of Koch, as herein amended.

The Office Action on page 2 states that, “[t]he independent claims do not define the ‘condition’, for updating the presence information, and in silent regarding the updating of information for active and inactive buddy devices.” The Applicant has therefore amended the claims to clarify the invention.

Applicant respectfully submits that the combination of Michael, Salomaki, and Koch does not teach or suggest all the claim limitations as set forth in independent claim 1, as amended. For example, independent claim 1 recites, “the presence updates are sent via a traffic channel (TCH) independent of call activity involving the MS,” which is neither taught nor suggested in the combination of Michael, Salomaki, and Koch.

Koch on page 5, para [0063] states “... Buddy Call Waiting Service... a call from a buddy may be alerted to the subscriber when the subscriber is already engaged with another call. If the caller is not a buddy, the caller may hear a busy tone.” Koch further on page 5, para [0067] states “...SCP 140 may consult the buddy list in database ... if caller 130 is determined not to be a buddy... SCP 140 sends a default response to SSP 116 ... to play a busy tone for caller 130 ... caller 130 hears a busy tone, indicating subscriber 110 is not available to receive the call.” Further, Koch on page 5, para [0068] states “... caller 130 is a buddy... SCP 140 sends a buddy response to SSP 116. The buddy response may be an Authorize\_Termination message. The buddy response may also comprise a ControllingLegTreatment field. The ControllingLegTreatment field may contain a standard call waiting tone indication...SSP 116 alerts subscriber 110 with the standard calling waiting tone.” Therefore, Koch describes that the presence information regarding the buddy is indicated with the standard call waiting tone, however this happens only when the caller is in a call with the subscriber. In contrast, Applicant’s claim recites (emphasis added) “the presence updates are sent via a traffic channel (TCH) independent of call activity involving the MS,” which is not taught or suggested by Koch.

For example, call waiting information in Koch, as cited, is sent only when the buddy calls the subscriber and only pertains to the buddy and the fact that the buddy is

calling. This is not true of presence information. In the example cited in Koch, call waiting information is not sent about the buddy when the buddy is not calling the subscriber. Again, this is not true of presence information. Hence, there is no teaching or suggestion provided in Koch, as cited, that presence information from the buddy list presence information would be sent to update the subscriber, when the subscriber is not involved in a call. Therefore, Koch fails to describe sending presence information for the buddy via the TCH independent of call activity involving the MS.

Further, Applicant's WPP maintains the updated buddy list presence information for the MSs which are subscribed to receive the information from the WPP. This presence information in Applicant's WPP is also related to the devices which are unavailable for interaction with the subscriber. And, presence information regarding devices which are available and devices which are unavailable is sent to the MS. However, Koch sends the call waiting information only when the caller calls the subscriber. For the above reasons, the combination of Michael, Salomaki, and Koch fails to disclose Applicant's claimed invention as claimed in independent claim 1, and Applicant respectfully requests withdrawal of the rejection of independent claim 1 under 35 USC 103(a). Applicant requests that independent claim 1 now be passed to allowance.

Dependent claims 2, 5 – 8, 10, 11, 13, and 16 – 20 have either been canceled or depend from, and include all the limitations of independent claim 1, as amended. Therefore, Applicant respectfully requests the reconsideration and withdrawal of their rejection.

Rejection of claims 3, 4, 9, and 12 under 35 U.S.C. 103(a) as being unpatentable over US 2004/0170263 (Michael et al), US 2003/0065788 (Salomaki), and US 2004/0234061 (Koch et al.), and further in view of US 2002/0129103 (Birkler et al.)

Dependent claims 3, 4, 9, and 12 have either been canceled or depend from, and include all the limitations of independent claim 1, as amended. Therefore, Applicant respectfully requests the reconsideration and withdrawal of their rejection.

Rejection of claims 14 and 15 under 35 U.S.C. 103(a) as being unpatentable over US 2004/0170263 (Michael et al), US 2003/0065788 (Salomaki), and US 2004/0234061 (Koch et al.), and further in view of Black.

Dependent claims 14 and 15 have been canceled.

Rejection of claims 21, 29, and 33 under 35 U.S.C. § 103(a) as being unpatentable over US 2002/0035605 (McDowell et al.) in view of US 2004/0234061 (Koch et al.)

Applicant has amended the claims to clarify the invention. Applicant therefore respectfully requests reconsideration of the rejection of claims 21, 29, and 33 under 35 U.S.C. § 103(a) as being unpatentable over McDowell in view of Koch, as herein amended.

Applicant respectfully submits that the combination of McDowell and Koch does not teach or suggest all the claim limitations as set forth in independent claims 21 and 33, as amended. For example, independent claim 21 recites (emphasis added), “receiving, by the MS, updated buddy list presence information via the TCH independent of call activity involving the MS” which is neither taught nor suggested in the combination of McDowell and Koch. Independent claim 33 recites (emphasis added), “adapted to receive an updated buddy list presence information via the TCH and the transceiver independent of call activity involving the MS” which is also neither taught nor suggested in the combination of McDowell and Koch.

For the reasons mentioned above with respect to claim 1, there is no teaching or suggestion provided in Koch, as cited, that presence information from the buddy list

presence information would be sent to update the subscriber, when the subscriber is not involved in call activity. Therefore, Koch fails to describe sending presence information for the buddy via the TCH independent of call activity involving the MS. Hence, the combination of McDowell and Koch do not teach or suggest the claim language of “receiving, by the MS, updated buddy list presence information via the TCH independent of call activity involving the MS” (emphasis added) as recited by independent claim 21, as amended, nor the claim language of “adapted to receive an updated buddy list presence information via the TCH and the transceiver independent of call activity involving the MS” (emphasis added) as recited by independent claim 33, as amended. Therefore, the Applicant respectfully requests withdrawal of the rejection of independent claims 21 and 33 under 35 U.S.C 103.

Dependent claim 29 depends from, and includes all the limitations of independent claim 21. Therefore, Applicant respectfully requests the reconsideration of dependent claims 21 and requests withdrawal of its rejection.

Rejection of claims 22 – 28 and 30 under 35 U.S.C. § 103(a) as being unpatentable over US 2002/0035605 (McDowell et al.) and US 2004/0234061 (Koch et al.), and further in view of US 2002/0129193 (Birkler et al.)

Dependent claims 22 – 28 and 30 have either been canceled or depend from, and include all the limitations of independent claim 21, as amended. Therefore, Applicant respectfully requests the reconsideration and withdrawal of their rejection.

Rejection of claim 31 under 35 U.S.C. § 103(a) as being unpatentable over US 2002/0035605 (McDowell et al.), US 2004/0234061 (Koch et al.), and US 2002/0129193 (Birkler et al.), and further in view of US 2003/0073440 (Mukherjee et al.)

Dependent claim 31 has been canceled.

Rejection of claim 32 under 35 U.S.C. 103(a) as being unpatentable over US 6,895,425 (Kadyk et al) in view of US 2003/0065788 (Salomaki), and further in view US 2004/0234061 (Koch et al.)

Applicant has amended the claims to clarify the invention. Applicant therefore respectfully requests reconsideration of the rejection of claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Kadyk in view of Salomaki and further in view of Koch, as herein amended.

Applicant respectfully submits that the combination of Kadyk, Salomaki, and Koch does not teach or suggest all the claim limitations as set forth in independent claim 32, as amended. For example, independent claim 32 recites, “presence information from the buddy list presence information to update the MS independent of call activity involving the MS” (emphasis added) which is neither taught nor suggested in the combination of Kadyk, Salomaki, and Koch.

For the reasons mentioned above with respect to claim 1, there is no teaching or suggestion provided in Koch, as cited, that presence information from the buddy list presence information would be sent to update the subscriber, when the subscriber is not involved in call activity. Therefore, Koch fails to describe sending presence information for the buddy via the TCH independent of call activity involving the MS. Hence, the combination of McDowell and Koch do not teach or suggest the claim language of “presence information from the buddy list presence information to update the MS independent of call activity involving the MS” (emphasis added) as recited by independent claim 32, as amended. Therefore, the Applicant respectfully requests withdrawal of the rejection of independent claim 32 under 35 U.S.C 103.

Conclusion

Since none of the references cited, either independently or in combination, teach all of the limitations of the independent claims, or therefore, all the limitations of their respective dependent claims, it is asserted that neither anticipation nor a prima facie case for obviousness has been shown. Thus, Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Such action is earnestly solicited by the Applicant. Should the Examiner have any questions, comments, or suggestions, the Examiner is invited to contact the Applicant's attorney at the telephone number indicated below.

Lastly, please charge any additional fees (including extension of time fees) or credit overpayment to Deposit Account No. **502117 -- Motorola, Inc.**

Respectfully submitted,

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